

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/522,586  
Confirmation No. : 5634  
Applicant : Andrea Seger  
Filed : 26 Jan. 2005  
Title : Method for updating device description for field  
devices of process automation technology  
TC/A.U. : 8146  
Examiner : S. Taha  
Docket No. : SEGE3003/FJD  
Customer No. : 23364

**RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Notification of Non-Compliant Appeal Brief, submitted herewith is a copy of the REPLY TO ADVISORY ACTION filed on September 13, 2010.

The Notification indicates that "The brief does not contain a correct copy of the appealed claims as an appendix thereto..." In fact, the brief does include the proper appealed claims. This fact is clear from a consideration of the REPLY noted above. To re-iterate, the claims on appeal are claims 7 (with the subject matter of claim 8 which was cancelled), claim 9 and claim 11. The combination of claims 7 and 8 was introduced by the REQUEST FOR RECONSIDERATION WITH AMENDMENT filed on August 12, 2010. This amendment was not entered as indicated in the Advisory Action of September 3, 2010. It was this refusal that was addressed in the REPLY noted above. The refusal to enter the amendment was error because the combination of claims 7 and 8 could not give rise to a "new issue," since the combination of claims 7 and 8 is nothing more than previous claim 8 in independent form.

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The examiner was in error in not entering the combination of claims 7 and 8, and for this reason, the brief included the combination of claims 7 and 8.

Since, the failure to enter the amendment combining claims 7 and 8 was due to an error on the part of the USPTO, the issuance of the NOTIFICATION is also an error of the USPTO. Accordingly, this RESPONSE should not carry with it an extension of time. As a precaution, however, a two month extension of time is included herewith, although it is respectfully suggested that the request should not be entered and it should be returned to the undersigned.

The appeal should now proceed accordingly.

Respectfully submitted,

BACON & THOMAS, PLLC



Felix J. D'Ambrosio  
Reg. No. 25,721

February 24, 2011

**BACON & THOMAS, PLLC**

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GENERAL RECEIPT

Atty Ref. SEGE3003/FJD

IN RE APPLICATION OF: Andrea Seger et al

APPLICATION NO.: 10/522,586

FILED: January 26, 2005

FOR: METHOD FOR UPDATING DEVICE DESCRIPTION FOR FIELD DEVICES OF PROCESS  
AUTOMATION TECHNOLOGY

DELIVER TO:  MAILROOM  ART UNIT \_\_\_\_\_

SPECIAL INSTRUCTIONS:

THE PTO STAMP HEREON ACKNOWLEDGES RECEIPT OF:

REPLY TO ADVISORY ACTION  
NOTICE OF APPEAL  
NOTICE OF APPEAL FEE- \$540

Filed by:FJD



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COOPY



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**COPY**

**REPLY TO ADVISORY ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Receipt of the Advisory Action of September 3, 2010 is gratefully acknowledged.

In the Advisory Action, the examiner indicated that “[f]or purposes of appeal, the proposed amendment(s): ....will not be entered...” because “further search and/or consideration would be necessitated by the proposed change in scope of the claims..”

The amendment that was filed to the claims on August 12, 2010 merely added the subject matter of claim 8 to claim 7. In effect this amounts to nothing more than placing claim 8 in independent form. No new matter was added by the amendment. Therefore, no basis exists for alleging that “further search and/or consideration would be necessitated..” Claim 8 had already been searched.

A Notice of Appeal is being filed concurrently herewith, and it is

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respectfully requested that the previous amendment be entered so that the appeal can proceed for claims 7, 9 and 11.

Respectfully submitted,



Felix J. D'Ambrosio  
Reg. No. 25,721

September 13, 2010

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